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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,277	10/14/2003	Scott C. Moose	85435THC	7227

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EXAMINER

BAREFORD, KATHERINE A

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,277

Applicant(s)

MOOSE, SCOTT C.

Examiner

Katherine A. Bareford

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1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.
- claims 2-3 and 7-8 are canceled.*

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment of Nov. 25, 2005 has been received and entered.

Claim Objections

1. The objection to claims 1 and 6 because of informalities is withdrawn as the proposed corrections suggested by the Examiner in the August 18, 2005 Office action to claims 1 and 6 were made in the Nov. 25, 2005 amendment.

WB 2. Claim 11^{is} objected to because of the following informalities: in new claim 11, line 2, "butyrl" should be "butyral" to correspond to the spelling of the term in the specification at page 4, line 14. Note also the spelling in claim 12.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 4-6 and 9-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) In claim 1, section b) applicant has amended the claim to require a source of "an organic solvent-based liquid coating". Similarly, in independent claim 6, at line 4, applicant has amended the claim to require the hopper to be "dimensioned for delivering an organic solvent-based liquid bead coating composition". However, these amendments are new matter. In the specification and claims as originally filed, there is no teaching that a general "organic solvent-based liquid coating" is applied. There is simply one example where a specific organic solvent is used (methyl ethyl ketone) (see page 4, lines 14-15). There is no indication that because this single solvent is used that the use of all possible organic solvents is disclosed or suggested. As a result, the use of a general "organic solvent-based liquid coating" is new matter.

(B) In claim 1, section a), applicant has amended the claim to require "the pattern of circumferential grooves include from about 1.6 grooves per mm. to about 4 grooves per mm." This requirement is also made in independent claim 6, at lines 9-11. In the amendment, applicant provides no indication of where the basis is for this requirement. Original claims 3 and 8 required "at least" or "greater" than 1.6 grooves per mm. This does not provide "about" 1.6 grooves per mm as now claimed. Furthermore, while examples are provided in the specification of 40, 70, 80 and 100 grooves per inch, with 40 grooves per inch providing defective coating, none of these corresponds to the upper

limit of 4 grooves per inch (100 grooves/inch provides 3.93 grooves/mm). As a result, the use of the range as claimed is new matter.

5. In the amendment of Nov. 25, 2005, applicant argues that as to the claimed use of an "organic solvent-based liquid coating", ^{it} is fully supported by the application as originally filed. According to applicant, the terms "liquid coating", "liquid composition", "liquid coating composition", "solvent coating" are used throughout the application as filed, and moreover, an example of an organic solvent-based coating is given (polyvinyl butyral in methyl ethyl ketone). Applicant argues that the terms rejected have full support in the application as originally filed, and one skilled in the art would recognize that the example given is just one of many organic solvent-based coatings that can be used to carry out the present invention.

The Examiner has reviewed these arguments, however, the rejection is maintained. While the application as filed refers to liquid coatings, etc. it is well known in the art of coating that liquid coatings can be, for example, aqueous based or molten, and the mere indication that a coating is liquid would not suggest that any organic solvent-based coating can be used. In the entire specification as originally filed, a single example of a coating material with a single organic solvent is described (polyvinyl butyral in methyl ethyl ketone). As discussed in MPEP 2163.05 (section 1 "Broadening Claim", under heading "Addition of Generic Claim"), it is indicated that the written description requirement for a claimed genus (here organic solvent-based coatings) can

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be satisfied through sufficient description of a representative number of species. The section goes on to note that

A "representative number of species" means that the species which are adequately described are representative of the entire genus. Thus, when there is substantial variation within the genus, one must describe a sufficient variety of species to reflect the variation within the genus. >The disclosure of only one species encompassed within a genus adequately describes a claim directed to that genus only if the disclosure "indicates that the patentee has invented species sufficient to constitute the gen[us]." See *Enzo Biochem*, 323 F.3d at 966, 63 USPQ2d at 1615. "A patentee will not be deemed to have invented species sufficient to constitute the genus by virtue of having disclosed a single species when ... the evidence indicates ordinary artisans could not predict the operability in the invention of any species other than the one disclosed." In re *Curtis*, 354 F.3d 1347, 1358, 69 USPQ2d 1274, 1282 (Fed. Cir. 2004) (Claims directed to PTFE dental floss with a friction-enhancing coating were not supported by a disclosure of a microcrystalline wax coating where there was no evidence in the disclosure or anywhere else in the record showing applicant conveyed that any other coating was suitable for a PTFE dental floss.)<

In the present case, there is certainly substantial variation within the genus of "organic solvent-based coatings" and from the single example provided, one of ordinary skill in the art would not be able to predict that all "organic solvent based coatings", as allowed by the present claims, would be operable in the present invention.

Claim Rejections - 35 USC § 103

6. The rejection of claims 1, 3-6 and 8-10 under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (US 5552188) in view of Levy (US 4428724) and Quiel et

al (US 2002/0164431) is withdrawn due to applicant's amendments of Nov. 25, 2005 as to the allowable range of grooves per mm.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 4-6 and 9-12 have been considered but are moot in view of the new ground(s) of rejection.

While the 35 USC 103 rejection of the claims has been withdrawn, the claims are rejected under 35 USC 112, first paragraph, as containing new matter for the reasons discussed in the rejection above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date


of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (571) 272-1413. The examiner can normally be reached on M-F(6:00-3:30) with the First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and for After Final communications.

Other inquiries can be directed to the Tech Center 1700 telephone number at (571) 272-1700.

Furthermore, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KATHERINE BAREFORD
PRIMARY EXAMINER